

### **REMARKS**

Claims 1-3, 6-12, 14-18, 20-22, 46 and 48-69 are pending in the present application. By this amendment, new claims 67-69 are added. Support for new claims 67-69 may be found in Applicants' original specification in at least the following locations: page 2, lines 1-5 (claims 67 and 69); and page 5, lines 2-5 (claim 68). Applicants respectfully request reconsideration of the present claims in view of the following remarks.

#### **I. Formal Matters:**

##### **April 28, 2006 Telephone Interview**

Applicants' representative thanks Examiner Nordmeyer for discussing the present claims and the February 28, 2006 Office Action during an April 28, 2006 telephone interview. As a result of our telephone interview, Examiner Nordmeyer agreed to send out a Telephone Interview Summary stating that the finality of the February 28, 2006 Office Action would be removed. Further details discussed in the April 28, 2006 telephone interview are incorporated into the arguments below.

For the reasons discussed in the April 28, 2006 telephone interview and the reasons given below, Applicants respectfully submit that the finality of the February 28, 2006 Office Action is premature and all of previously presented claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 are allowable over the art of record.

##### **Premature Final Rejection:**

Applicants respectfully submit that a clear issue regarding the rejection of previously presented claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 has not been developed between Examiner Nordmeyer and the Applicant. As addressed in § 706.07 of the MPEP, "Before final rejection is in order, a clear issue should be developed between the examiner and applicant." In addition, since no other basis for rejecting previously presented claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 was set forth in the Office Action, the finality of the subject Office Action should be withdrawn as premature and improper under MPEP § 706.07.

Applicants submit that a clear issue has not been developed between Examiner Nordmeyer and the Applicants regarding the art used in the rejection of claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66. Examiner Nordmeyer has rejected claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,410,120 to Frost et al. (hereinafter, "Frost'120") in view of U.S. Patent No. 6,049,419 to Wheatley et al. (hereinafter, "Wheatley"). However, in addition to Frost'120 and Wheatley, Examiner Nordmeyer appears to rely on U.S. Patent No. 6,352,754 to Frost et al. (hereinafter, "Frost'754") to reject claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 even though Frost'754 is not mentioned as being relied upon. For example, on page 3, lines 13-18 of the February 28, 2006 Office Action, Examiner Nordmeyer relies on Figure 3, component #8 to reject claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66; however, Frost'120 does not disclose a Figure 3. Frost'754 does disclose a Figure 3 depicting a component #8. Given the uncertainty of which references are being relied upon by Examiner Nordmeyer, Applicants submit that a clear issue has not been developed between Examiner Nordmeyer and the Applicants regarding the art used in the rejection of claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66.

For at least the reasons given above, Applicants submit that the finality of the February 28, 2006 Office Action is premature. Given the reasons stated above, Examiner Nordmeyer agreed to remove the finality of the February 28, 2006 Office Action. Accordingly, notification of the withdrawal of the finality of the February 28, 2006 Office Action is respectfully requested in the next office action.

## II. Prior Art Rejections:

### Rejection of Previously Presented Claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 Under 35 U.S.C. §103(a) in View of Frost'120 In Combination With Wheatley

Previously presented claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,410,120 to Frost et al. (hereinafter, "Frost'120") in view of U.S. Patent No. 6,049,419 to Wheatley et al. (hereinafter, "Wheatley"). This rejection is respectfully traversed.

The teaching of Frost'120 is directed to curved, laminated glazings for thermally insulation or heated windows in a motor vehicle. See, Frost'120, column 1,

lines 16-21. Such laminated glazings usually comprise at least one metallic silver layer sandwiched between dielectric layers. See, Frost'120, column 1, lines 16-21, and column 4, lines 19-22.

Referring to FIG. 1, the disclosed curved, laminated glazings comprise outer curved panes 21 and 22, adhesive films 31 and 32 positioned between panes 21 and 22, thin support film 4 positioned between adhesive films 31 and 32, thin layer 5 positioned between support film 4 and adhesive film 31, and black firing paint 6 positioned between adhesive film 31 and pane 21.

As noted by Examiner Nordmeyer on page 3, lines 18-21 of the February 28, 2006 Office Action, the teaching of Frost'120 fails to disclose a transparent optical sheet comprising a non-metallic birefringent multi-layer optical film. Specifically, Examiner Nordmeyer states:

However, Frost et al. fail to disclose a non-metallic birefringent multi-layer optical film and wherein the optical film is a film from the group consisting of infrared reflecting films, polarized films, non-polarized films, multi-layer films, colored films, tinted films and decorative films.

Examiner Nordmeyer suggests that one skilled in the art, given the teaching of Frost'120, would have been motivated to seek out the teaching of Wheatley, and then modify the disclosed laminates of Frost'120 by cutting the Wheatley non-metallic birefringent multi-layer optical film in a manner described in Frost'120 and then substituting the cut non-metallic birefringent multi-layer optical film for the metallic support film 4/thin layer 5 used in the laminates of Frost'120. Specially, Examiner Nordmeyer states on page 4, lines 6-10 of the February 28, 2006 Office Action:

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the non-metallic birefringent multi-layer optical film that has many applications that include infrared reflecting films, polarized films, and multi-layer films instead of the film layer in Frost et al. in order to have an optical body that reduces the required cooling of an automobile in the summer as taught by Wheatley.

Applicants disagree.

Applicants respectfully submit that there is no suggestion in the teaching of Frost'120 or Wheatley of the need or desire to cut and then substitute a non-metallic birefringent multi-layer optical film, as disclosed in Wheatley, for the cut metal, thermally insulating layer (i.e., support film 4/thin layer 5) disclosed in the laminates of Frost'120 as suggested by Examiner Nordmeyer. It is respectfully submitted that the teaching of Frost'120 does not, in any way, suggest to one skilled in the art the need or desirability of Wheatley's non-metallic birefringent multi-layer optical films over Frost'120's metal, thermally insulating layers (i.e., support film 4/thin layer 5) with regard to providing thermal insulation. As noted by the Court in *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990), "The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

Examiner Nordmeyer suggests that one skilled in the art would have been motivated to substitute the non-metallic birefringent multi-layer optical films disclosed in Wheatley for the metal, thermally insulating layers (i.e., support film 4/thin layer 5) of Frost'120 "in order to have an optical body that reduces the required cooling of an automobile in the summer as taught by Wheatley." Applicants note that the metal, thermally insulating layers (i.e., support film 4/thin layer 5) of Frost'120 provide thermal insulation. See, Frost'120, column 1, lines 16-19, and column 4, lines 19-22. Given that Frost'120's metal, thermally insulating layers (i.e., support film 4/thin layer 5) are thermal insulating, it is not clear to Applicants why one skilled in the art, given the teaching of Frost'120 and its disclosed metal, thermally insulating layers (i.e., support film 4/thin layer 5), would modify the laminated glazings of Frost'120 as suggested by Examiner Nordmeyer.

Further, Applicants respectfully submit that there is no suggestion in the teaching of Frost'120 or the teaching of Wheatley of the need or desire to cut a non-metallic birefringent multi-layer optical film, as required in Frost'120, so as to avoid potential problems of wrinkling associated with Wheatley's non-metallic birefringent multi-layer optical films. As disclosed in International Patent Publication No.

WO01/96104 (cited on page 13, line 14 of Applicants' original specification as disclosing suitable non-metallic birefringent multi-layer optical films for use in the present invention), potential problems of wrinkling associated with non-metallic birefringent multi-layer optical films, such as those disclosed in Wheatley, are addressed, not by cutting the non-metallic optical film as used to address wrinkling of metallic films in Frost'120, but by heat-setting the non-metallic birefringent multi-layer optical film so as to control shrinkage and minimize wrinkling. Given WO01/96104's disclosed methods of minimizing wrinkling problems associated with non-metallic birefringent multi-layer optical films by heat-setting the film, Applicants respectfully submit that one skilled in the art would not have been motivated to cut Wheatley's non-metallic birefringent multi-layer optical film and substitute the cut film into the laminates of Frost'120 in order to avoid wrinkling of a non-metallic birefringent multi-layer optical film. There is no evidence in the teaching of Frost'120 or the teaching of Wheatley that Wheatley's non-metallic birefringent multi-layer optical films have a problem of wrinkling similar to Frost'120's metal, thermally insulating layers (i.e., support film 4/thin layer 5).

Applicants respectfully submit that the only motivation for modifying the disclosed laminates of Frost'120 has been gleaned from Applicants' original specification, not from what is taught or suggested in the art of record. As stated by the Court, "One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention", *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

For at least the reasons given above, Applicants respectfully submit that the proposed combination of the teaching of Frost'120 with the teaching of Wheatley is improper and that Examiner Nordmeyer has failed to make a *prima facie* case of obviousness. The proposed combination of the teaching of Frost'120 with the teaching of Wheatley fails to make obvious Applicants' claimed invention as recited in independent claims 1, 18, 46 and 55. Accordingly, withdrawal of this rejection is respectfully requested.

Regarding independent claim 18, each of the teachings of Frost'120 and Wheatley fails to teach, disclose or suggest a laminate in which at least a substantial

portion of a peripheral edge of an optical film, disposed between two glazing components, extends beyond a peripheral edge of at least one of the glazing components. In contrast to Applicants' claimed invention in independent claim 18, Frost'120 discloses laminates that require support film 4/thin layer 5 to be completely positioned within curved panes 21 and 22 (see, for example, FIG. 1).

It should be noted that Examiner Nordmeyer admits that the teaching of Frost'120 is directed to laminates in which support film 4/thin layer 5 is positioned completely within curved panes 21 and 22 (see, for example, FIG. 1). On page 3, lines 9-11 of the February 28, 2006 Office Action, Examiner Nordmeyer states:

The optical film is completely within the peripheral edges of the glazing components (Figure 1, #5, 21 and 22).

Even if one of ordinary skill in the art would have been motivated to substitute the non-metal film of Wheatley for the metallic film of Frost'120 as suggested by Examiner Nordmeyer (and Applicants submit that there is no motivation to do so other than Applicants' own specification), the resulting combination would still fail to teach, disclose or suggest a laminate in which at least a substantial portion of a peripheral edge of an optical film, disposed between two glazing components, extends beyond a peripheral edge of at least one of the glazing components.

Regarding independent claim 46, each of the teachings of Frost'120 and Wheatley fails to teach, disclose or suggest a kit for making a laminate, wherein the kit comprises a transparent optical sheet comprising a non-metallic birefringent multi-layer optical film and the optical sheet is dimensioned so as to extend beyond the peripheral edge of at least one glazing component to which the optical sheet is to be adhered. In contrast to Applicants' claimed invention in independent claim 46, Frost'120 discloses a laminate that requires support film 4/thin layer 5 to be completely positioned within curved panes 21 and 22 (see, for example, FIG. 1).

Even if one of ordinary skill in the art would have been motivated to substitute the non-metal film of Wheatley for the metallic film of Frost'120 as suggested by Examiner Nordmeyer (and Applicants submit that there is no motivation to do so other than Applicants' own specification), the resulting combination would still fail to teach,

disclose or suggest a kit for making a laminate, wherein the kit comprises a optical sheet that is dimensioned so as to extend beyond a peripheral edge of at least one glazing component to which the optical sheet is to be adhered.

For at least the reasons given above, Applicants respectfully submit that the proposed combination of the teaching of Frost'120 with the teaching of Wheatley, even if proper, fails to make obvious Applicants' claimed invention as recited in claims 1-3, 6-12, 14-18, 20-22, 46 and 48-66. Accordingly, withdrawal of this rejection is respectfully requested.

III. Conclusion:

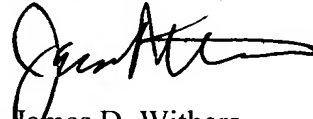
For at least the reasons given above, Applicants submit that claims 1-3, 6-12, 14-18, 20-22, 46 and 48-69 define patentable subject matter. Accordingly, Applicants respectfully request allowance of these claims.

No additional fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 503025.

Should Examiner Nordmeyer believe that anything further is necessary to place the application in better condition for allowance, Examiner Nordmeyer is respectfully requested to contact Applicants' representative at the telephone number listed below.

Respectfully submitted,

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